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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,896	02/15/2001	Mark I. Greene	PENN-0743	3799

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EXAMINER

TUNG, JOYCE

ART UNIT PAPER NUMBER

1637

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

MS

Advisory Action

Application No.

09/783,896

Applicant(s)

GREENE ET AL.

Examiner

Joyce Tung

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 1 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: please see the attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☒ Newly proposed or amended claim(s) claims 16-17 and claims 22-23 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: please the attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: claims 16-17 and 22-23.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 11, 14-15, 18-21 and 24-27.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

The applicant's amendment filed 6/10/2004 to the Office action mailed 2/12/2004 was not entered. Without entering the amendment, claims 1, 11, and 14-27 are pending.

1. The newly added phrases "a quanta" and "directly proportional to" raise new issue which requires further consideration and search.
2. Claims 1, 11 and 14 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being respectively unpatentable over claim 5-11 of copending Application No. 09/624,946 and over claims of copending Application No. 09/977,716 since there is no terminal disclaimer filed.
3. Regarding the premature final rejection, the response argues that the Office action mailed February 12, 2004 argues that the claim does not recite that the method claim contains a limitation that is quantitative and this point was not raised in the Office action mailed May 30, 2003 in that the motivation statement states that "in order to quantify molecules expression a selected epitope in a sample", one of ordinary skill in the art would have combined the teachings of Eberwine and Sano. However, the preamble indicates that the method is for quantifying molecules expression a selected epitope in a sample. The amount of signal, zero or no zero is a kind of quantification which is indicative of epitope detector bound to the surface and molecules expressing the selected epitope in the sample. As previously presented (See the amendment filed 10/30/2003), in claim 1 there is no quantification step for quantifying molecules expressing a selected epitope in a sample. Thus, the final rejection made was proper and maintained.

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4. Without entering the amendment filed 6/10/2004, claim 1, 15 and 18-20 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Eberwine et al. (5,922,553, issued 7/13/1999) in view of Sano et al. (5,665,539, issued 9/9/1997).

5. Without entering the amendment filed 6/10/2004, claims 11, 14 and 24-26 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eberwine et al. (5,922,553, issued 7/13/1999) in view of Zeytinoglu et al. (5,874,226, issued 2/23/1999).

6. Claims 21 and 27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eberwine et al. (5,922,553, issued 7/13/1999) as respectively applied to claims 1 and 11 above, and further in view of Shannon (6,132,997, issued Oct. 17, 2000).

7. Claims 16-17 and 22-23 are allowable.

8. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

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9. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung J.T.
July 1, 2004


GARY BENZION, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600